

**REMARKS**

Applicant submits herewith proposed new versions of FIGS. 3 and 4, as well as proposed new versions of FIGS. 6-12. The proposed new versions of FIGS. 3 and 4 rectify the problems set forth in the first paragraph on page 2 of the Office Action. The legend in box 501 of FIG. 5 has been changed so it is consistent with the specification. The proposed new versions of FIGS. 6-12 are described in the application as filed. Included with the replacement figures are annotated copies of FIGS. 6-12 which indicate, adjacent each of the boxes, the specific portions of the specification where the elements of the drawing are described. Accordingly, the proposed new versions of FIGS. 3-12 do not introduce new matter and are in conformance with the application as filed. The Examiner is requested to authorize admission of the proposed new versions of FIGS. 3-12.

The specification has been amended for clarity and syntax. Support for the change from reference numeral "813" to --413-- and from "412" to --413--, respectively, on page 15, line 3, and page 16, lines 3 and 4, appears in the application as filed on page 10, lines 13 and 14, and page 15, lines 6 and 7. Support for the change of reference numeral "402" to --412-- on page 15, line 9, appears in the application as filed on page 10, lines 11 and 12. Support for the word "user" on page 16, line 26, appears in the application as filed on page 10, lines 19 and 20. The change from reference numeral "1102" to --1101-- on page 18, line

17, is to correct an obvious drafting error because step 1102 obviously depends upon the results of steps 1100 and 1101, rather than itself.

Claim 9 has been amended to overcome the objection to it. Claim 12 has been amended to eliminate the requirement for restoring the user settings archived partition area. Page 17, lines 8-16, provides support for restoring the back-up area partition. Consequently, claim 12 now conforms with 35 U.S.C. §112, first paragraph.

Claim 5 has been amended to overcome the rejection based on 35 U.S.C. §112, second paragraph.

Applicant notes that claim 3, upon which claim 7 depends, has been indicated as containing allowable subject matter. To this end, claim 3 has been combined with claim 1, upon which it formally depended. Consequently claims 3 and 7 should now be allowed.

In combining claims 1 and 3, some syntax changes were made in the steps defined by claim 3. These syntax changes have no effect on substantive issues. Syntax and spelling changes were made in claim 7; these changes also have no effect on substantive issues.

Claims 1, 2, 4-6, 9 and 10 have been amended for clarity. Claims 17-19, directed to a computer program product storing a program for causing the computer entity of the independent claims 1, 3 and 13, have been added. These claims also require the

computer entity to be a headless computer. Claims 20-35 have been added. Claims 20 and 32 are respectively similar to claims 1 and 13. However, claims 20 and 32, as well as the claims dependent thereon, are directed to a headless computer entity comprising a data processor arrangement and at least one storage device. Claims 20-35 indicate the processor arrangement of the headless computer entity performs the steps of the method claims. The newly-added claims are allowable for reasons similar to those about to be advanced in connection with the rejections based on the prior art.

Prior to discussing the rejections based on the prior art in detail, attorney for applicant notes that many of the rejections appear to be based on inherency. The Examiner equates certain features of the claimed elements to structures and/or steps of the cited art. However, there is no specific indication in the references of the equivalence advanced by the Examiner. In addition, the Examiner has provided no rationale or evidence to support his position that the equivalence exists. The Examiner is reminded of the burden associated with establishing a proper rejection based on inherency.

The fact that a certain result or characteristic **may** occur or be present in the prior art is not sufficient to establish the inherency of that result or characteristic. *In re Rijckaert*, 9 F.3d 1531, 1532, 28 U.S.P.Q.2d 1955, 1956 (Fed. Cir. 1993); *In re Oelrich*, 666 F.2d 578, 581-82, 212 U.S.P.Q. 323, 326 (C.C.P.A.

1981). To establish inherency, extrinsic evidence must make clear that the missing descriptive matter is **necessarily** present in the thing described in the reference and that it would be so recognized by persons of ordinary skill in the art. Inherency may not be established by possibilities or probabilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient. *In re Roberston*, 169 F.3d 743, 745, 49 U.S.P.Q.2d 1949, 1950-51 (Fed. Cir. 1999). In relying upon a theory of inherency, the Examiner must provide a basis in fact or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the prior art. *Ex parte Levy*, 17 U.S.P.Q.2d 1461, 1464 (B.P.A.I. 1990).

In rejecting claim 1 as being anticipated by Erpeldinger, U.S. Patent 6,557,169, the Examiner says column 3, lines 44-46, of Erpeldinger discloses copying a back-up operating system from a back-up source onto an operating system back-up area partition that is not used for direct running of an operating system by a computer entity. However, column 3, lines 44-46 of Erpeldinger states:

The backup partition includes free storage space to hold the partition image of the new operating system to be stored.

This portion of Erpeldinger never states that the backup partition is not used for direct running of an operating system by the computer entity. The Examiner must, based on the

foregoing discussion about inherency, provide evidence or rationale for his position that the back-up area partition of Erpeldinger is not used for direct running of an operating system.

The Examiner also states that column 4, lines 5 and 6, of Erpeldinger discloses copying user settings data from a back-up source to a user settings archive partition area. Column 4, lines 5 and 6, of Erpeldinger states, "Again, the user customization information is saved into backup partition of the work station."

The Examiner must provide rationale or evidence that the customization information saved into the backup partition of the work station is the equivalent of copying user settings data from a backup source to user settings archive partition area.

Based on the foregoing, the Examiner has not met the burden of proving Erpeldinger anticipates the features of claim 1. Consequently, the anticipation rejection of claims 4, 6 and 8, that depend on claim 1, is incorrect.

The rejection of claims 2, 10 and 11 as being unpatentable over Erpeldinger in view of Tamori et al., U.S. Patent No. 5,960,445, is erroneous because Tamori et al. fails to cure the foregoing deficiencies of Erpeldinger. The rejection of claim 9 as being obvious as a result of Erpeldinger in view of the *Authoritative Dictionary of IEEE Standard Terms*, 2000, IEEE Press, Seventh Edition, page 395, is also incorrect because the

Dictionary fails to cure the foregoing defects in claim 1, upon which claim 9 defines.

Many of the dependent claims rejected on anticipation grounds also include features not disclosed by Erpeldinger. For example, the Examiner states that Erpeldinger discloses in column 4, lines 11 and 12, the claim 6 step that requires forcing the computer entity to boot from an emergency operating system stored on an emergency operating system partition area of the data storage device. However, column 4, lines 11 and 12, of Erpeldinger merely state that a reboot of the work station on the maintenance partition is triggered. The Examiner has provided no rationale or evidence to support his position that the statement in column 4, lines 11 and 12 forces a computer entity to boot from an emergency operating system stored on an emergency operating system partition area of the data storage device.

Applicant traverses the rejection of claim 13 as being unpatentable over McGill III et al., U.S. Patent No. 5,469,573, in view of Colligan et al., U.S. Patent No. 6,519,762. Combining Colligan et al. with McGill III flies in the face of the relied on portion of McGill relating to copying plural operating system files from an operating system data partition onto a back-up medium. Column 5, lines 23-38, of McGill III et al. state that any and all files, including **all** operating system files, configuration files and device drivers currently residing on the PC hard disk are backed up during a partial or full back up of

the PC hard disk. Colligan et al., in column 7, lines 44-67, indicates that a factory downloaded software image on a hard disk is prone to corruption from a variety of sources. To overcome this problem, Colligan et al. provides a protected software restoration image on the hard disk and protects the software restoration image by making the restoration image deeply hidden, or by placing the restoration image in an unpartitioned area of the hard disk drive, or by placing the restoration image in a partitioned area with non-standard encoding (for example, encrypted), or other non-standard procedures implemented with respect to pointers in a master boot block record that indicates where things are on a hard disk drive. In other words, Colligan et al. indicates that the factory downloaded software image on the hard disk is to be protected from the remainder of the data on the hard disk. In consequence, in downloading as disclosed by McGill III et al., one of ordinary skill in the art would not look to Colligan et al. because Colligan et al. does want to mingle the factory downloaded software image on the hard disk with the remainder of the downloaded material. Such mingling is exactly opposite to the corruption problem Colligan et al. wishes to overcome. In other words, Colligan et al. teaches away from copying the factory downloaded software image on the hard disk to back-up media because such copying is likely to result in corruption of the factory downloaded software image. Because of

these factors, one of ordinary skill in the art would not have combined the two references.

With reference to claim 14, Applicant can also not agree that McGill III et al. and Colligan et al. make the feature of copying user data from a data partition of a data storage device to a back up media obvious. As pointed out above, Colligan et al. is so concerned with corruption of factory downloaded software images on the hard drive that the reference teaches away from backing up to a back-up medium.

Applicant also cannot agree that one of ordinary skill in the art would have backed up the factory downloaded software image on the hard disk of Colligan et al. to back-up media. Again, Colligan et al. is so concerned with protecting the factory downloaded software image that one of ordinary skill in the art would not have modified Colligan et al. to include copying user data from a secondary data partition of a data storage medium to back-up media.

Claim 16 is not rendered obvious by the combination of McGill III et al., Colligan et al. and Davis et al., U.S. Patent 6,427,091. Davis et al. does not cure the foregoing deficiencies with regard to the rejection of claim 13, upon which claim 16 depends.

The newly added apparatus claims are further patentable over the applied references by requiring a headless computer entity. None of the applied references appears to be concerned with a



headless computer entity. The primary reference, Erpeldinger, is concerned with a work station. Obviously, a work station is entirely different from a headless computer entity because a work station depends on and has significant human operator inputs. In contrast, a headless computer has virtually no human operator inputs. A work station also is quite different from a headless computer because a work station has a complete display. In contrast, a headless computer has virtually no display.


In view of the foregoing amendments and remarks, favorable reconsideration and allowance are respectfully requested and deemed in order.

Pursuant to 37 C.F.R. §1.136(a), Applicant hereby requests a one-month extension of time in which to file this response. Authorization for payment of the \$110 fee is attached. If in error, the Commissioner is hereby authorized to charge any required fees not otherwise paid, including extension and extra claims fees, to Deposit Account 07-1337.

Respectfully submitted,

**LOWE HAUPTMAN GILMAN & BERNER, LLP**

By:

  
Allan M. Lowe, Reg. No. 19,641

1700 Diagonal Road, Suite 300  
Alexandria, VA 22314  
703-684-1111 telephone  
703-518-5499 telecopier  
AML:rk:gmj

PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

Application No. 09/842,872

Inventor: GOLD, STEPHEN

Annotated Sheet

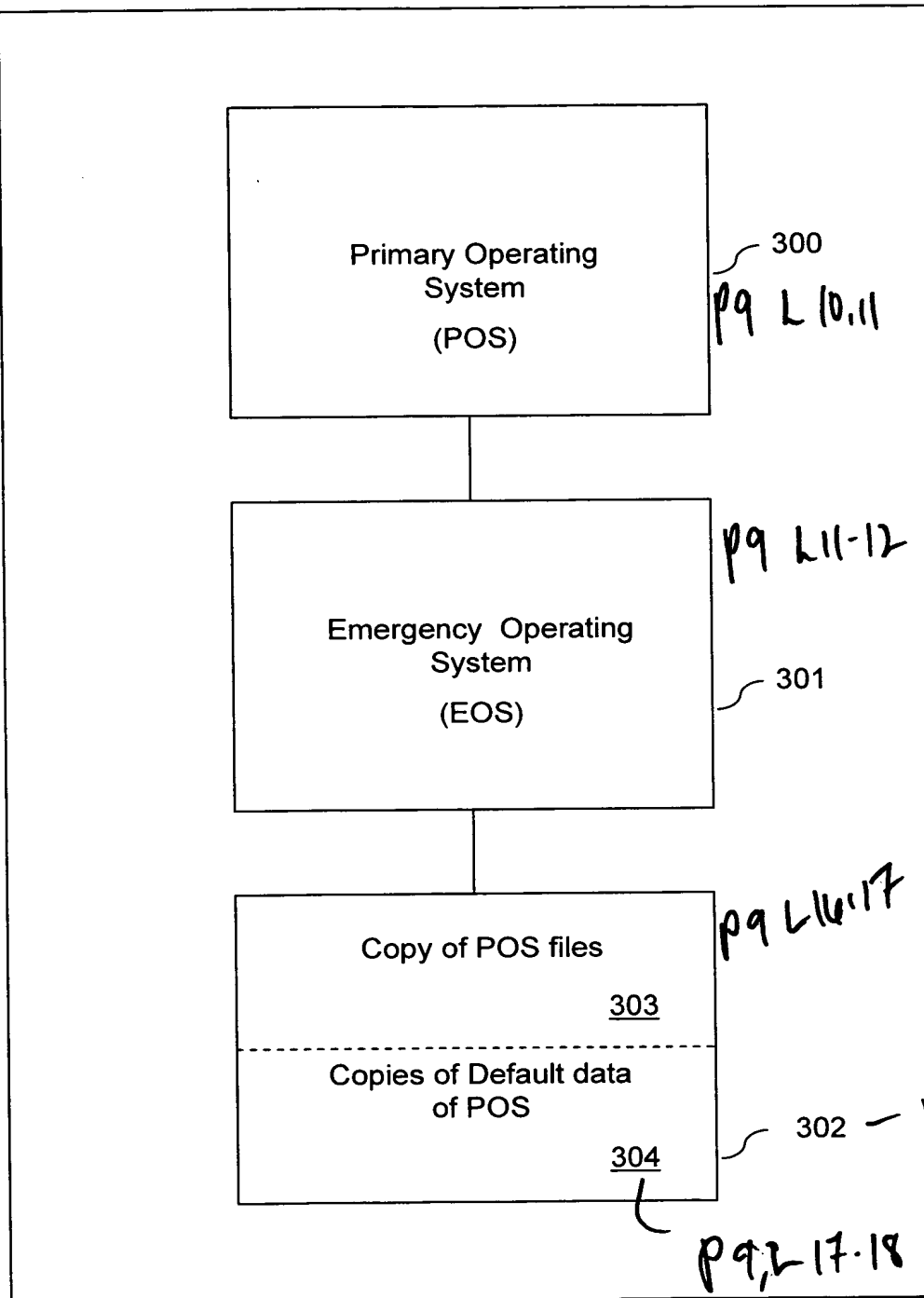


Figure 3



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

Application No. 09/842,872

Inventor: GOLD, STEPHEN

Annotated Sheet

4/15

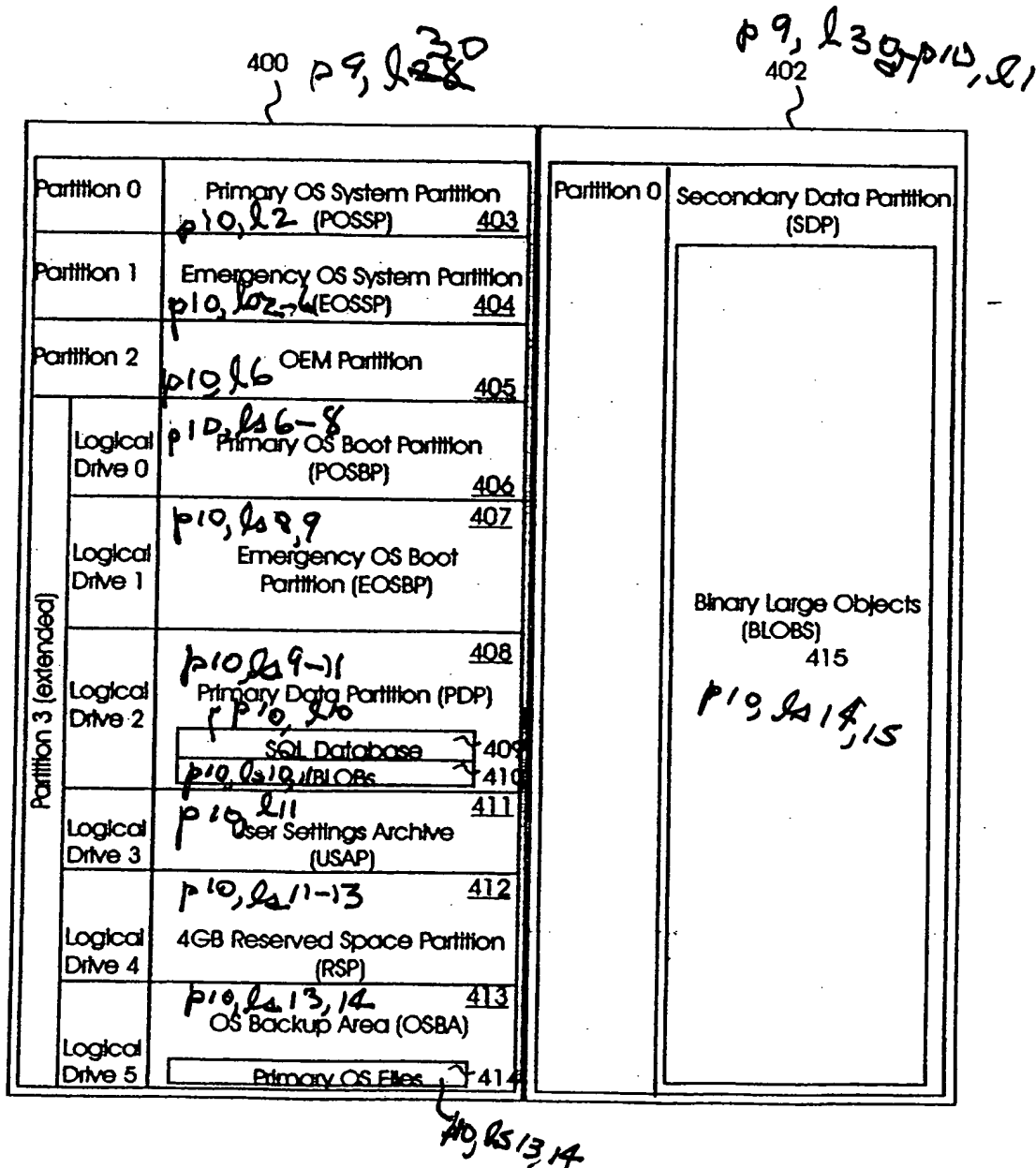


Fig. 4



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

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Annotated Sheet

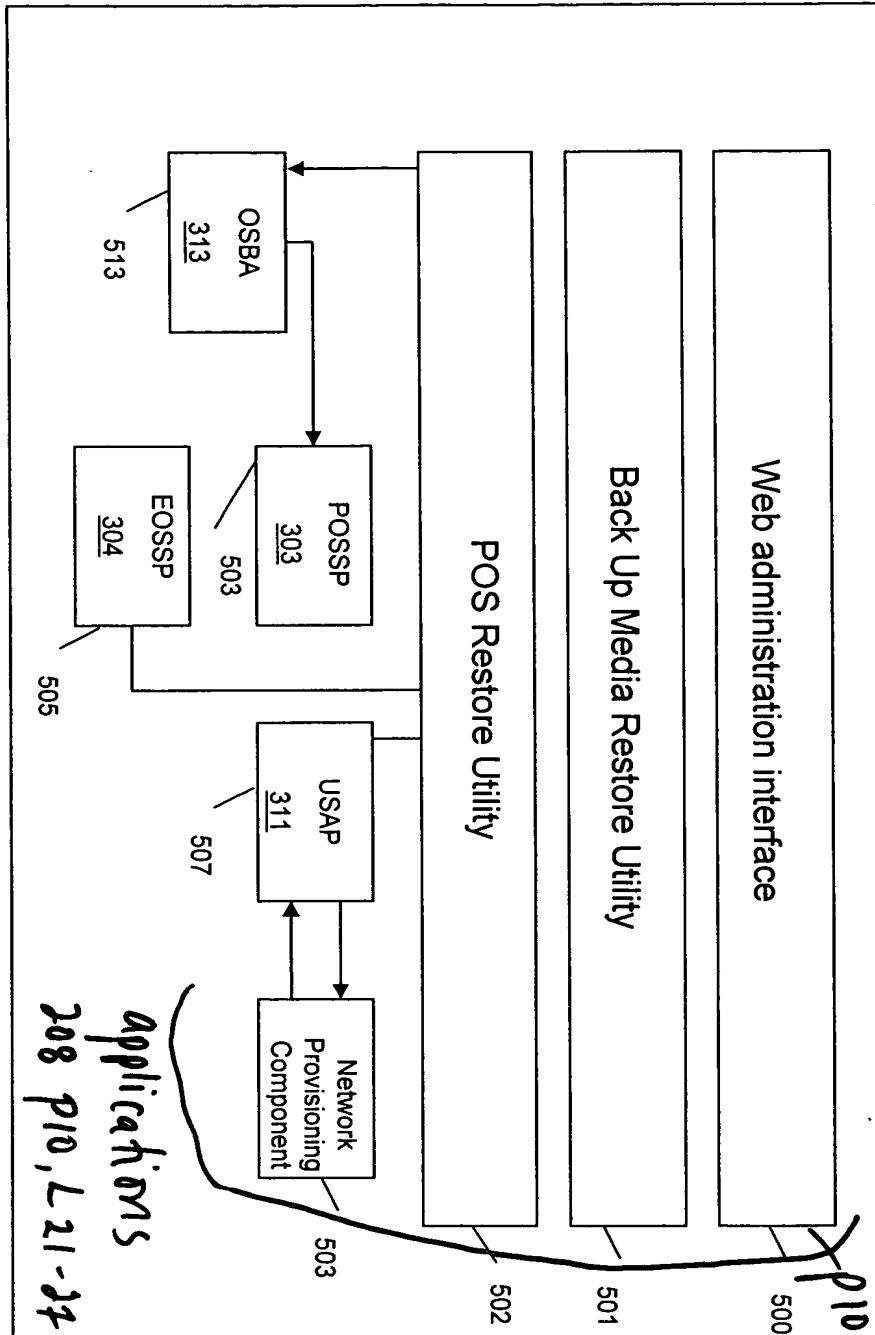


Figure 5



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

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Inventor: GOLD, STEPHEN

Annotated Sheet

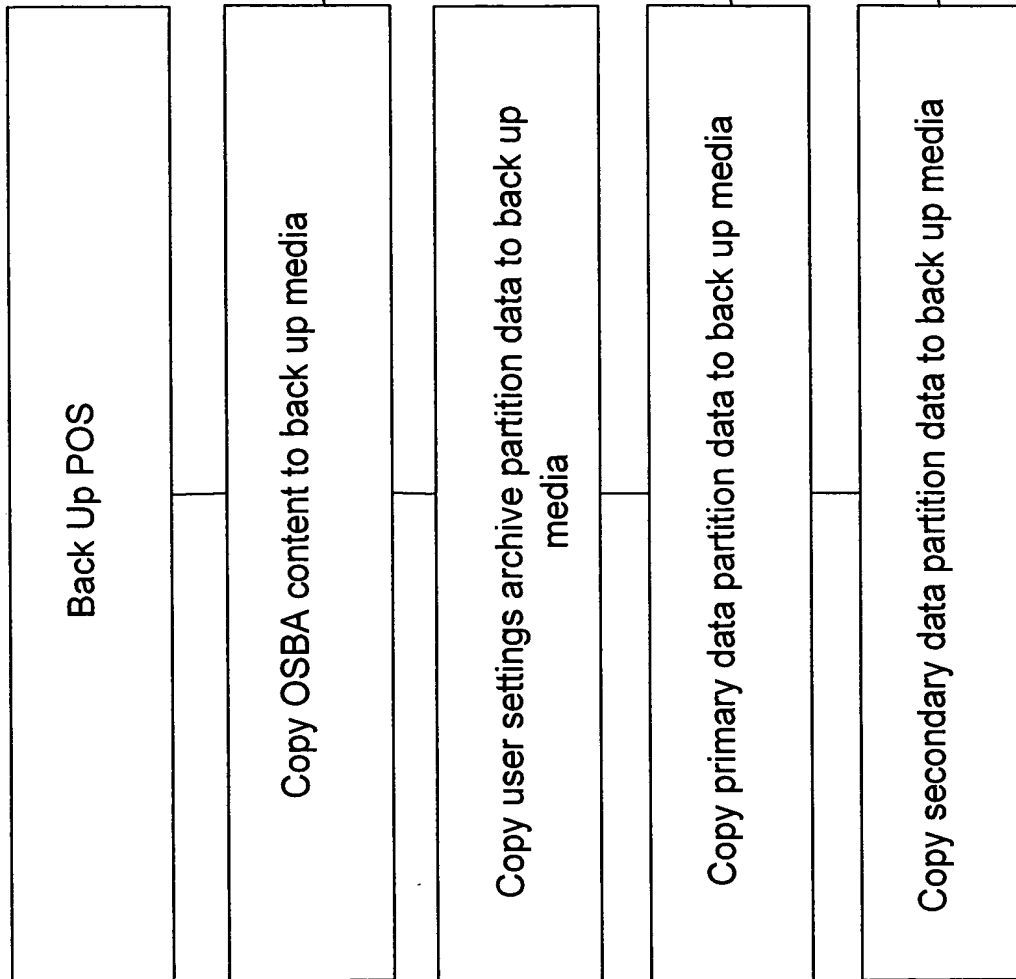


Figure 6

P7 L 7-8



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

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Annotated Sheet

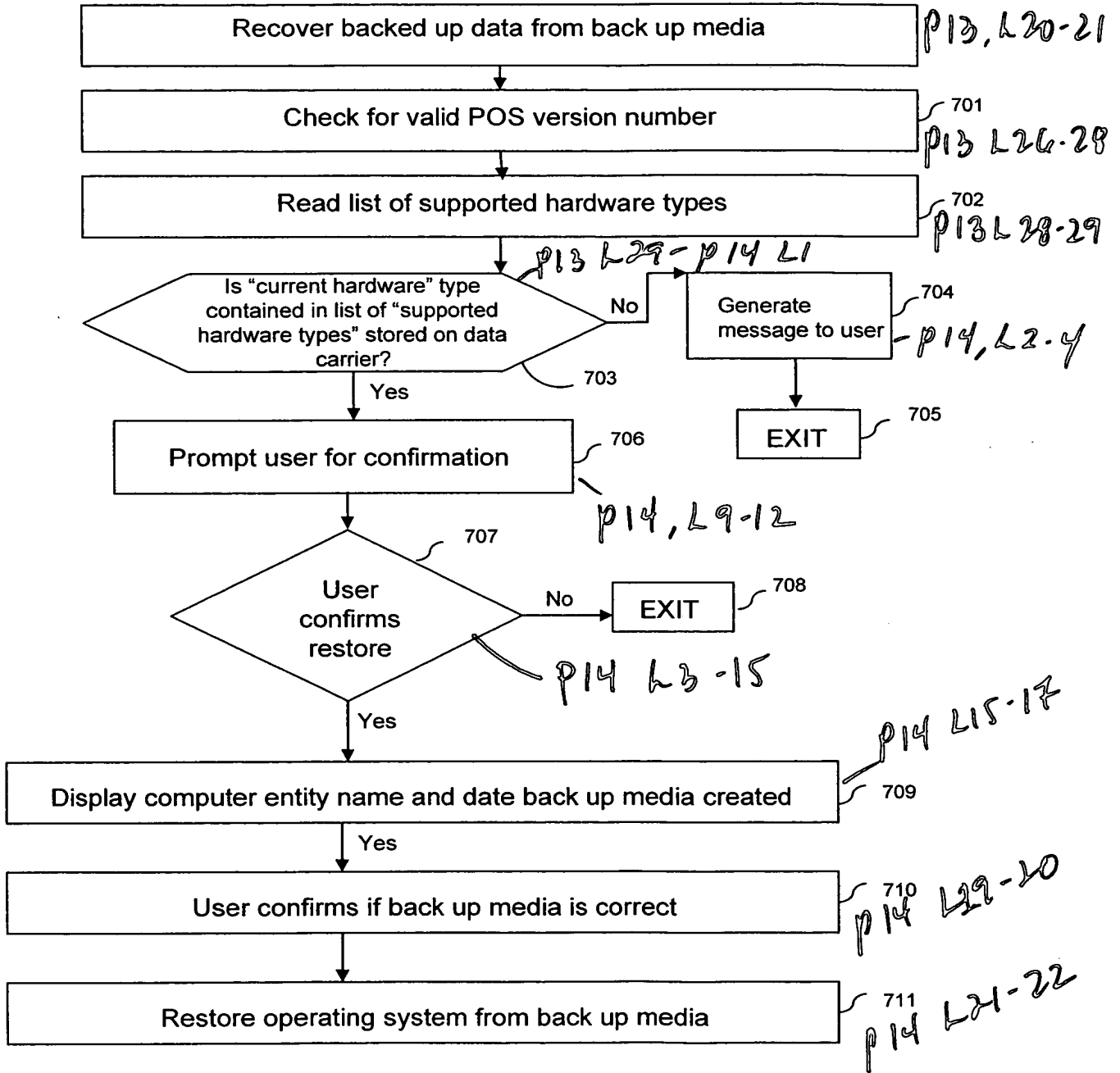
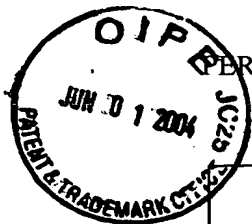


Figure 7

p 7 L10,11



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
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Annotated Sheet

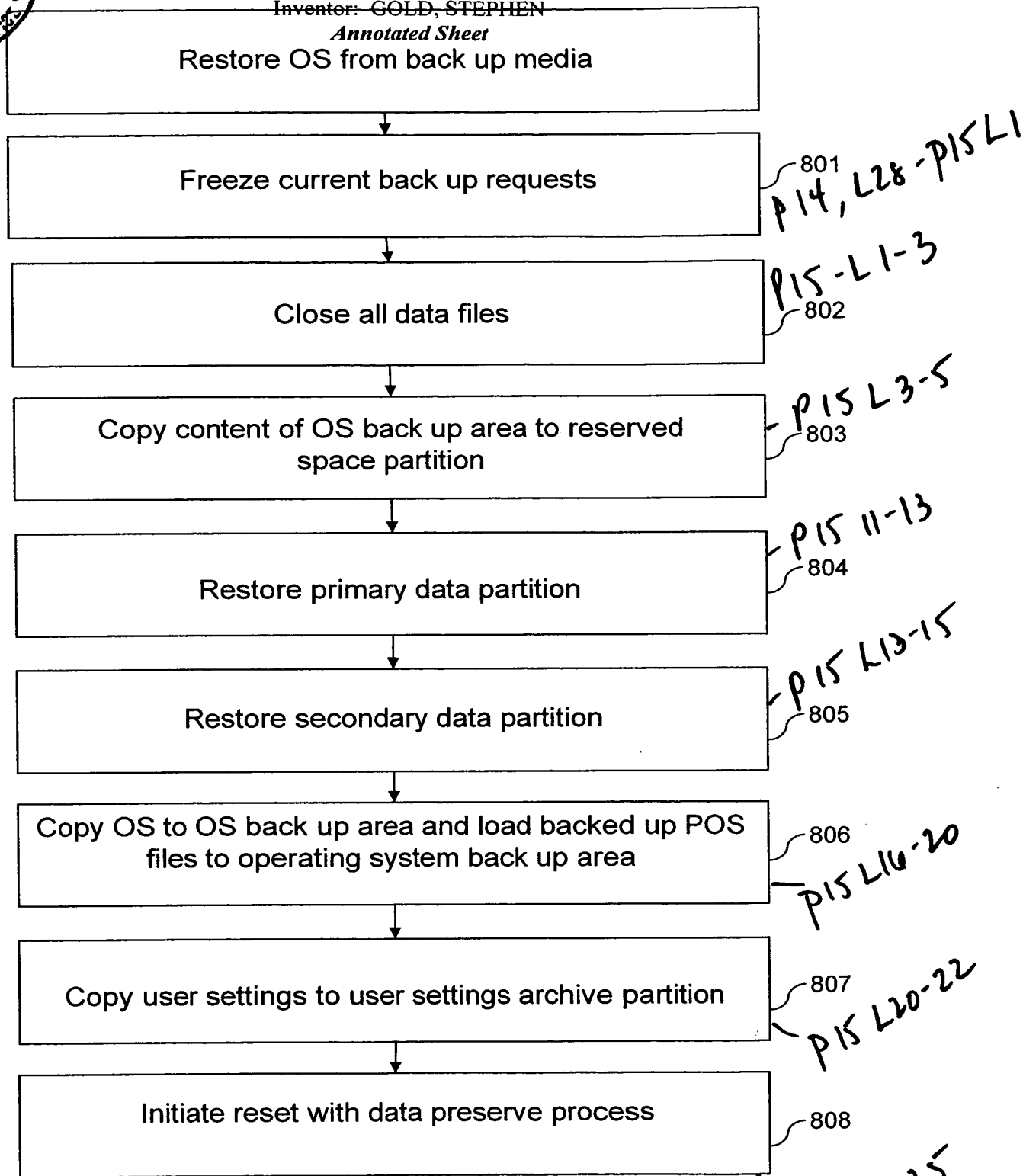


Figure 8

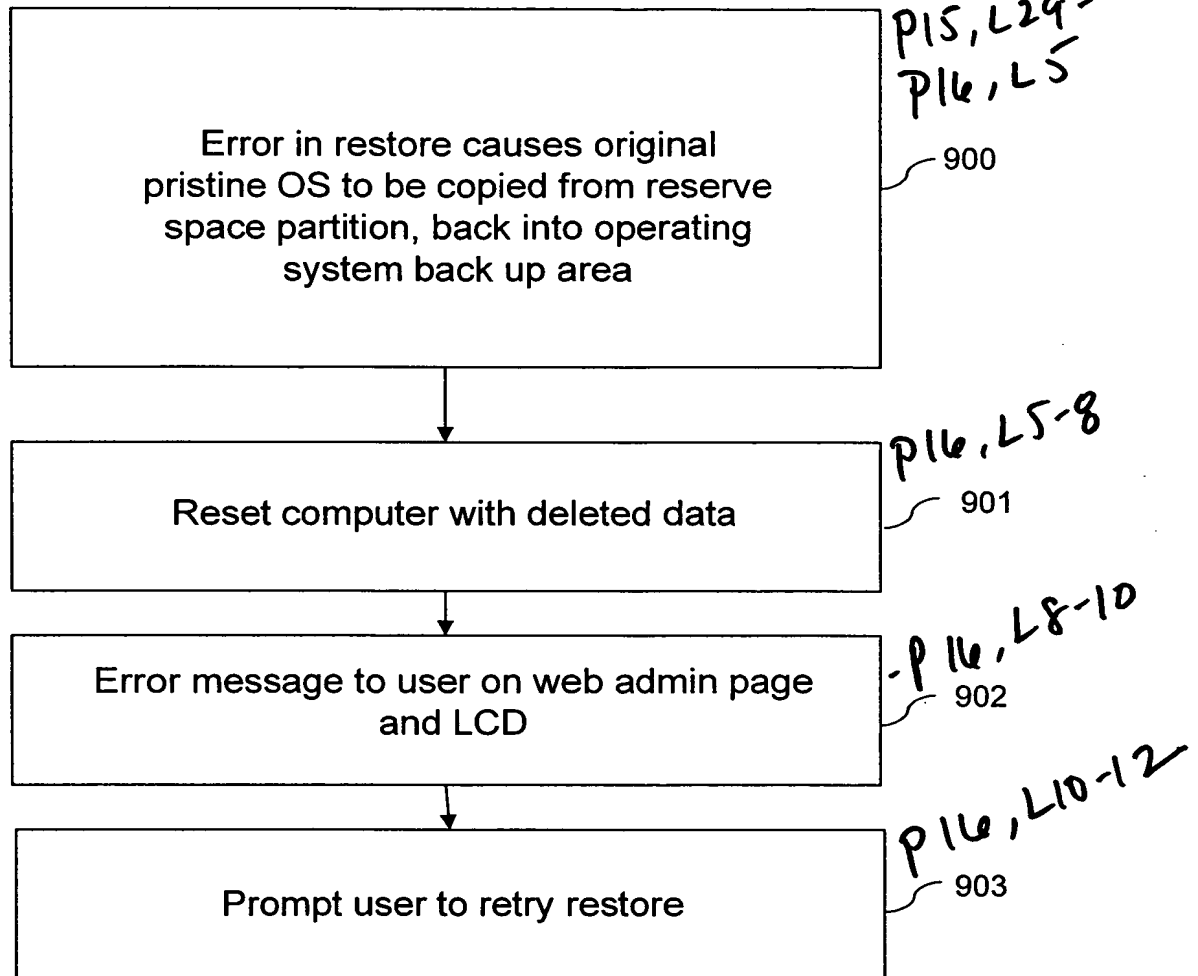
P7 L13-14



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
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*Annotated Sheet*



**Figure 9**

P7 L16-17



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

Application No. 09/842,872

Inventor: GOLD, STEPHEN

*Annotated Sheet*

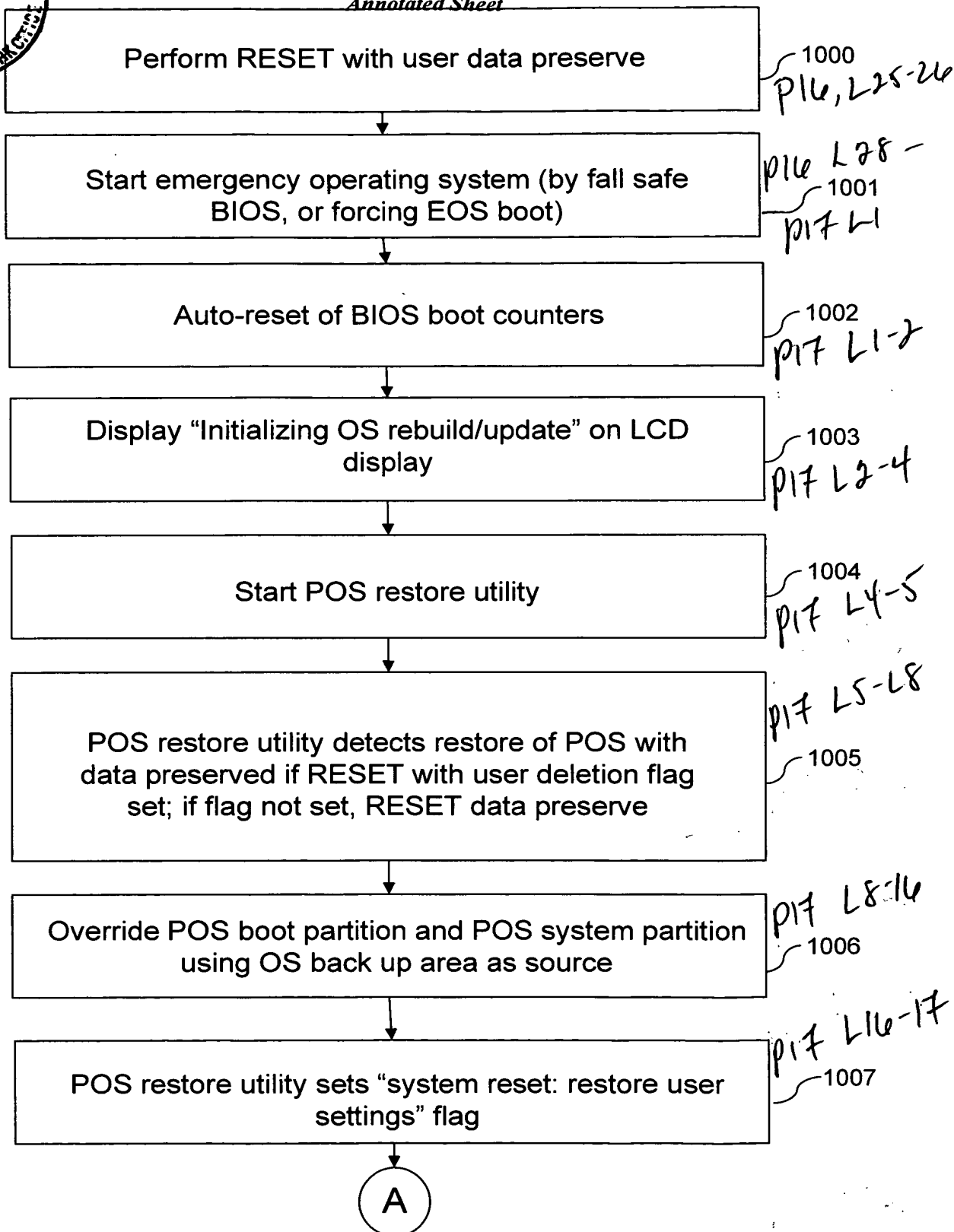


Figure 10A



PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

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Inventor: GOLD, STEPHEN

Annotated Sheet

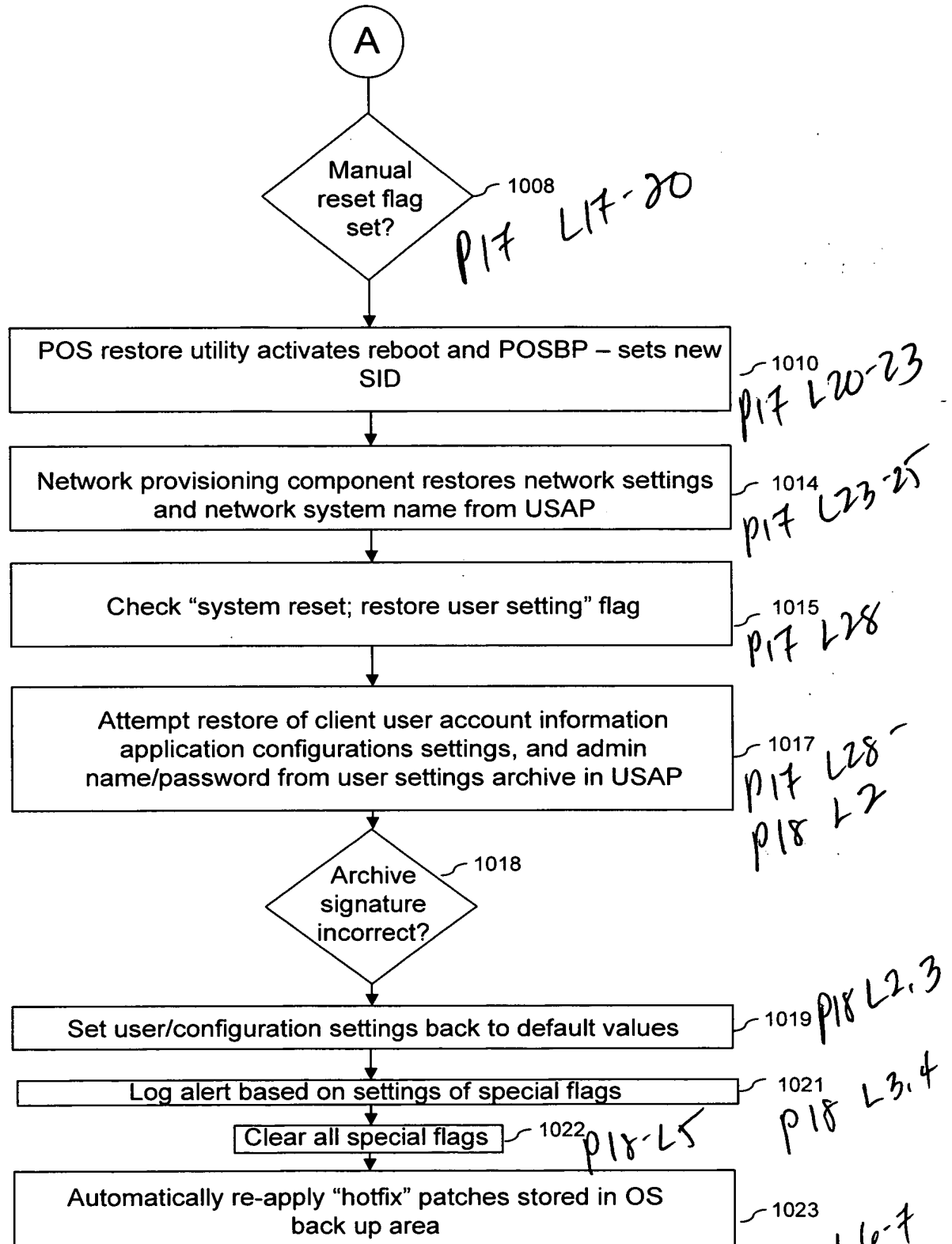


Figure 10b

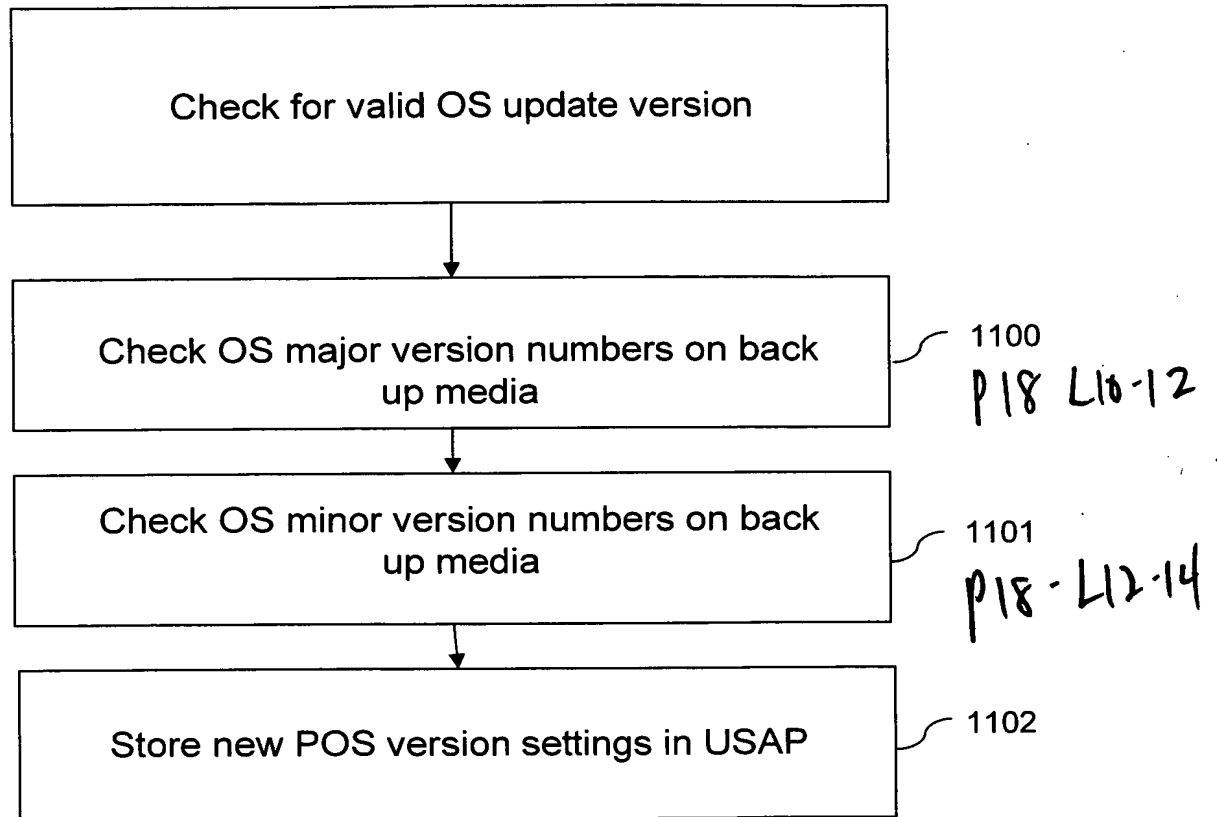


PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
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*Annotated Sheet*



**Figure 11**

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PERFORMING OPERATING SYSTEM RECOVERY FROM EXTERNAL BACK-UP  
MEDIA IN A HEADLESS COMPUTER ENTITY

Application No. 09/842,872

Inventor: GOLD, STEPHEN

Annotated Sheet

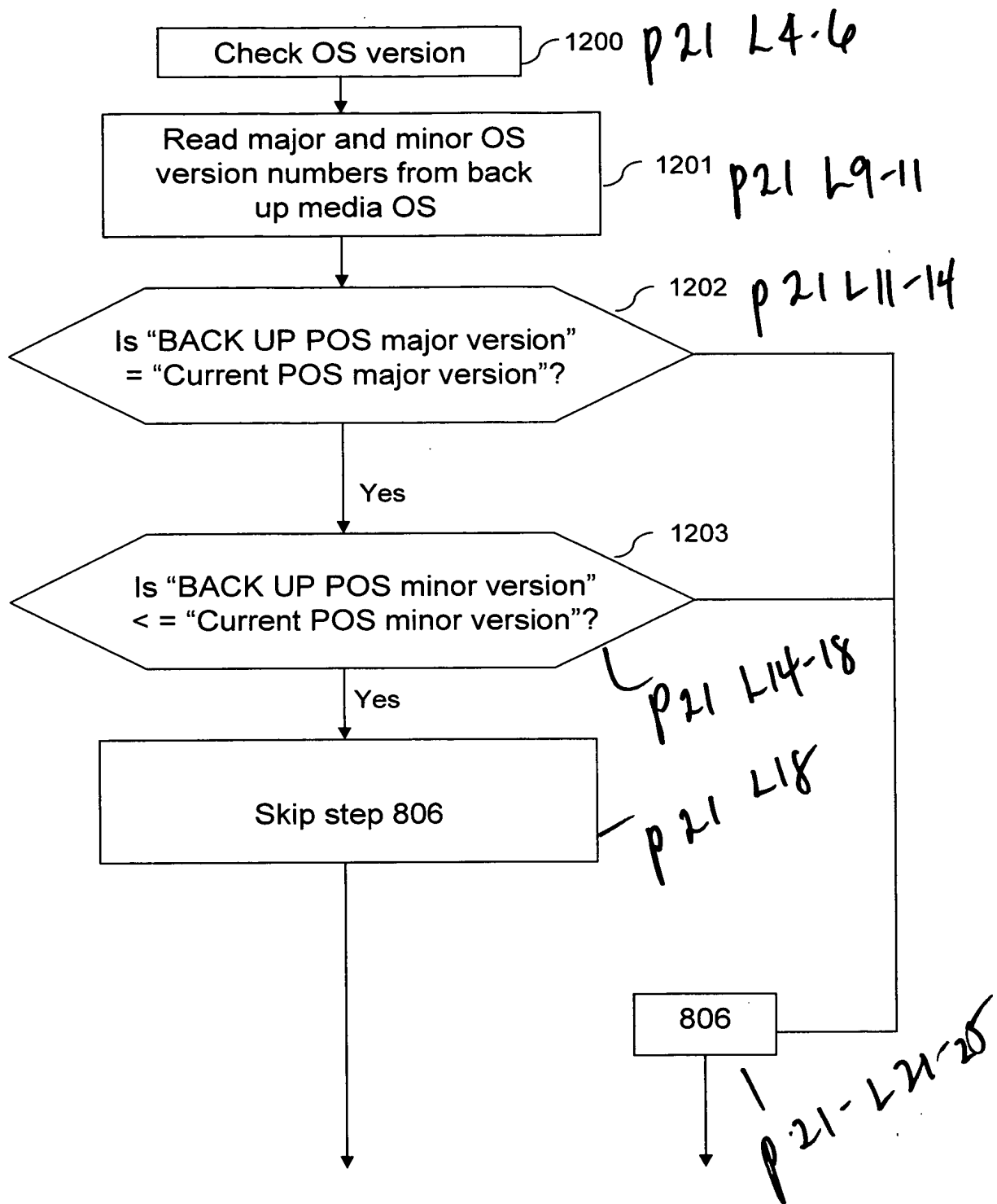


Figure 12